



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/531,773

04/19/2005

Thomas McGee

102790-002-(30034 US/3)

6033

27389 7590 03/30/2009
NORRIS, MCLAUGHLIN & MARCUS
875 THIRD AVE
18TH FLOOR
NEW YORK, NY 10022

EXAMINER

PURDY, KYLE A

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

03/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/531,773	Applicant(s) MCGEE ET AL.	
	Examiner Kyle Purdy	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/24/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3 pages
(04/19/2005, 06/06/2005, 06/13/2005).

DETAILED ACTION

Election Acknowledged

1. Applicant's election with traverse of the invention of Group I encompassing claims 1-8 and 11 in the reply filed on 12/24/2008 is acknowledged. The traversal is on the ground(s) that Groups I, II and III do not pose a serious burden on the examiner as all Groups are within the same class and subclass. This is not found persuasive. As was pointed out in the previous office action mailed on 12/05/2008, the Groups of inventions were separated as the inventive feature of the present application was suggested. Because the inventive concept was taught by the prior art, the invention lacked unity and separation of inventions is proper.

2. Applicant also elects with traverse the species of a wax. The traversal is on the ground(s) that all the species are sufficiently similar and a single coextensive search would yield ample art relating to the present invention without imposing a search burden upon the Examiner. As was pointed out in the office action mailed on 12/05/2008, the species disclosed are not only distinct from one another based on chemical and physical properties but are also taught by the prior art. Therefore, election is still deemed proper.

3. The requirement is still deemed proper and is therefore made FINAL.

Status of Application

4. Claims 1-11 are pending, claims 9 and 10 are withdrawn and claims 1-8 and 11 are presented for examination on the merits. The following rejections are made.

Priority

5. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Denmark on 02/26/2002. It is noted, however, that Applicant has not filed a certified copy of the DE 102-08-199.9 application as required by 35 U.S.C. 119(b).

6. Therefore, Applicant is granted a priority date of 10/21/2002.

Specification

7. It is noted that this application appears to claim subject matter disclosed in prior U.S. provisional application No. 60/419892, filed 10/21/2002. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months

Art Unit: 1611

from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

8. If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanekiyo et al. (JP 55025456, published 02/23/1980) in view of Kanda et al. (US 4923894, published 04/08/1990).

12. Kanekiyo is directed to slow release base material for volatile or sublimable substances. The slow release compositions are to comprise a water soluble pectic acid alkali metal salt (see instant claim 3) which is combined with an active substance such as a fungicide or insecticide together with either glycerin or polyethylene glycol as a means for controlling the rate of release (see instant claims 2 and 4). The composition may be in the form of a solid.

13. Kanekiyo fails to teach the pesticide as being an essential oil. Kanekiyo fails to teach the composition as being in the form of a powder.

Art Unit: 1611

14. Kanda cures this deficiency. Kanda is directed to microparticles having pesticidal activity. An exemplified pesticidal agents are essential oils such as lemon oil, citronella oil, peppermint oil and thymol oil (see column 5, lines 50-56; see instant claim 1). Kanda also teaches that powders are useful solid forms for carrying and delivering their sustained release microparticles.

15. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kanekiyo and Kanda with a reasonable expectation for success in arriving at a controlled release composition comprising an essential oil having pesticidal activity a supporting material such as metal salt and a means for controlled release such as polyethylene glycol. Kanekiyo teaches that their slow release composition is to provide a slow release of pesticidal actives. However, Kanekiyo fails to teach an essential oil as being the pesticidal active. This limitation is obvious. It is well known in the art that essential oils possess pesticidal activity. See Kanda. One would have been motivated to employ an essential oil in the composition of Kanekiyo with a reasonable expectation for success in arriving at a composition capable of effectively controlling pest populations. It is not inventive to pick and choose a known class of active agent and place them into well known structure for carrying and slowly releasing said agents. With respect to the composition being in the form of a powder, this is obvious. Kanekiyo teaches that the composition may be a solid, but fails to specifically teach the solid as being a powder. Kanda teaches that powder compositions are a useful means for carrying and delivering the pesticidal active. Thus, one would have been motivated to modify the teaching of Kanekiyo such that the resultant solid product was a powder for ease of carrying and delivering the pesticidal composition. Therefore, the invention as a whole is *prima facie*

Art Unit: 1611

obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

16. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanekiyo et al. (JP 55025456, published 02/23/1980) in view of Kanda et al. (US 4923894, published 04/08/1990) as applied to claims 1-4 above, and further in view of Geering (US 4275060, published 06/23/1981).

17. Kanekiyo and Kanda fail to teach the composition as being packaged.

18. Geering cures this deficiency. Geering is directed to methods for combating pests. The compositions are to be contained and packaged.

19. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kanekiyo, Kanda and Geering with a reasonable expectation for success in arriving at a packaged pesticidal composition. Although Kanekiyo and Kanda do not teach packaging their compositions, this limitation is obvious. Kits are commonly used in the art for advantages of convenience and economy. Moreover, although the claim recites a kit, no positive recitation of the kits ingredients/elements distinguishes the claim over the reference. Therefore, the invention as a whole is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

20. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saijo et al. (JP 02157070, published 08/10/1992) in view of Kanda et al. (US 4923894, published 04/08/1990).

21. Saijo is directed to a sustained release material. The material comprises an active substance such as an insecticide or fungicide, anhydrous silica or some other porous material (see instant claim 3) and glycerol (see instant claim 4).

22. Saijo fails to teach the pesticide as being an essential oil. Saijo also fails to teach the composition as being in the form of a powder.

23. Kanda cures this deficiency. Kanda is directed to microparticles having pesticidal activity. An exemplified pesticidal agents are essential oils such as lemon oil, citronella oil, peppermint oil and thymol oil (see column 5, lines 50-56; see instant claim 1). Kanda also teaches that powders are useful solid forms for carrying and delivering their sustained release microparticles.

24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Saijo and Kanda with a reasonable expectation for success in arriving at a controlled release composition comprising an essential oil having pesticidal activity a supporting material such as metal salt and a means for controlled release such as polyethylene glycol. Saijo teaches that their slow release composition is to provide a slow release of pesticidal actives. However, Saijo fails to teach an essential oil as being the pesticidal active. This limitation is obvious. It is well known in the art that essential oils possess pesticidal activity. See Kanda. One would have been motivated to employ an essential oil in the composition of Saijo with a reasonable expectation for success in arriving at a composition capable of effectively controlling pest populations. It is not inventive to pick and choose a known class of active agent and place them into well known structure for carrying and slowly releasing said agents. With respect to the composition being in the form of a powder, this is obvious. Saijo

Art Unit: 1611

fails to teach the compositions physical state. However, Kanda teaches that powder compositions are a useful means for carrying and delivering the pesticidal active. Thus, one would have been motivated to modify the teaching of Saijo such that the resultant solid product was a powder for ease of carrying and delivering the pesticidal composition. Therefore, the invention as a whole is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

25. Claims 1 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong et al. (US 2001/0036472, published 11/01/2001) in view of Kanda et al. (US 4923894, published 04/08/1990).

26. Wong is directed to liquid filled gelatin capsules into controlled release systems by multiple coatings. The compositions possess a liquid core for carrying the an active agent, wherein the core is surrounded by a gelatin coating (see instant claim 5, 7 and 8). The gelatin coating is useful for controlling the release of the encapsulated material. The liquid core comprises the active agents such as a pesticide and fungicide and the carrier of the active agent is a plant and animal oil (see [0079]; see instant claim 6).

27. Wong fails to teach the pesticide as being an essential oil.

28. Kanda cures this deficiency. Kanda is directed to microparticles having pesticidal activity. An exemplified pesticidal agents are essential oils such as lemon oil, citronella oil, peppermint oil and thymol oil (see column 5, lines 50-56; see instant claim 1).

29. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wong and Kanda with a reasonable expectation

Art Unit: 1611

for success in arriving at a controlled release composition comprising an essential oil having pesticidal activity a supporting material such as plant or animal oil and a means for controlled release such as a gelatin coating. Wong teaches that the composition is to comprise a mixture of an active agent such as a pesticide and an animal/plant oil wherein the mixture is encased in a gelatin capsule for sustained release of the active agent. However, Wong fails to teach an essential oil as being the pesticidal active. This limitation is obvious because it is well known in the art that essential oils possess pesticidal activity. See Kanda. One would have been motivated to employ an essential oil in the composition of Wong with a reasonable expectation for success in arriving at a composition capable of effectively controlling pest populations. It is not inventive to pick and choose a known class of active agent and place them into well known structure for carrying and slowly releasing said agents. Therefore, the invention as a whole is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

Conclusion

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1611

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Kyle Purdy/
Examiner, Art Unit 1611
March 18, 2009*

*/David J Blanchard/
Primary Examiner, Art Unit 1643*